

Remarks/Arguments

Consideration of the above-identified application in view of the following remarks is requested.

The claims pending and under consideration are claims 13, 23-24, 26-27, 30, and 32. Claim 13 has been amended without prejudice. Claims 25, 28, 29, and 31 have been withdrawn. Claims 1-12, and 14-22 have been cancelled without prejudice. It is respectfully submitted that no new matter has been added by virtue of the present amendment.

Claim Rejections – 35 U.S.C. § 103

In the Office Action the Examiner rejected claims 12, 23, 24, 26, 27, 30 and 32 under 35 U.S.C. 103(a) “as being unpatentable over Lavrova et al., Zhurnal Organicheskoi Khimmii (1974), 10(4), 761-5 in view of Naruto et al. EP 399814.” The Examiner noted that “[t]he instantly claimed compounds would have been obvious over [t]he prior art compounds in Lavrova prior art in view of the disclosure of Naruto compound having the carbonyl group at the related position with similar core structure with a pharmaceutical utility as anti-viral agent. . . .”

This rejection is traversed. It is respectfully submitted that the Lavrova et al paper, fails in the very least to teach, hint or suggest any utility for the cited compound. Further, Naruta et al. relates to drugs effective as promoters of the human Nerve Growth factor and accordingly useful in the treatment of peripheral nerve damage and of damage to the functioning of the central nervous system. It is respectfully submitted that EP399814 fails to recite anti-viral activity as mentioned by the Examiner. It is respectfully submitted that one of ordinary skill in the art would not be motivated to combine Lavrova et al with Naruta et al. as suggested by the Examiner as Lavrova et al. is fails to mention any pharmacological application of the cited compound.

Further, it is respectfully submitted that the one of ordinary skill in the art would not expect the combination of Lavrova et al. in view of Naruta et al., to result in selective HSD-11B inhibitors as neither Lavrova et al. nor Naruta et al. teach, hint or suggest that the compounds

therein are useful as HSD-11B selective inhibitors. As such, one of ordinary skill in the art would not be motivated make the claimed compounds with the expectation of an HSD-11B selective inhibitor.

Even assuming that one of ordinary skill would combine Lavrova et al. with Naruta et al., it is respectfully submitted that one of ordinary skill in the art would at most have expected that when departing from the Lavrova et al compound (for which no pharmacological activity is provided), the modification suggested by the Examiner would yield compounds with a similar pharmacological activity of the Naruta et al compounds, i.e. NGF promoters.

Thus, in view of the above, the Examiner is respectfully requested to withdraw the 35 U.S.C. § 103 rejection over the present claims.

Claim Objections:

In the Office Action the Examiner objected to claims 13, 23, 24, 26, 27, 30 and 32 as containing non-elected subject matter.

It is respectfully submitted that claims 13, 23, 24, 26, 27, 30 and 32 all include elected subject matter. Further is respectfully submitted that there is no teaching, hint or suggestion of the elected subject matter of claims 13, 23, 24, 26, 27, 20, and 32. Thus, the Examiner is respectfully requested to withdraw this objection with respect to these claims.

In view of the above-identified amendments and remarks, it is respectfully submitted that the application is now in condition for allowance.

Please charge any fees, which may be required for this submission to Johnson & Johnson Deposit Account 10-0750/PRD2023USPCT/DK.

Early favorable action on the merits is respectfully requested.

Respectfully submitted,

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